

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No. **3071**

In Re Application Of: TSUYOSHI MASUDA; STEVE N. TRAN; WEI-YOUNG WU

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/728,712	12/5/2003	NORDMEYER, PATRICIA L.	26822	1772	9956

Invention: **RUNNABLE SPLICE**



COMMISSIONER FOR PATENTS:

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**NOVEMBER 15, 2006**

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Dated: **JANUARY 4, 2007**

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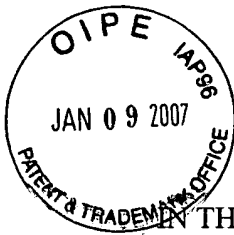
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Docket No.: 3071

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Steve Tran

Examiner: Nordmeyer, Patricia L.

Serial No.: 10/728,712

Art Unit: 1772

Filed: December 5, 2003

Title: RUNNABLE SPLICE

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### **BRIEF ON APPEAL**

This appeal is taken from a rejection of claims 1-11 of the hereinabove referenced patent application in a final Office Action mailed August 21, 2006; oral hearing is waived.

### **REAL PARTY OF INTEREST**

The present application is presently assigned to Ricoh Electronics, Inc. as evidenced by an assignment recorded December 5, 2003 on reel 014780, frame 0225.

### **RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences on applications related to the present application.

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**STATUS OF CLAIMS**

**Appealed Claims** (See Claims Appendix)

**Status**

1 (Previously Presented)

(1) Rejected under 35 U.S.C. 112, first paragraph  
(2) Rejected under 35 U.S.C. 103(a) on the basis of U.S. 5,472,755 to Nibling, Jr. in view of U.S. 4,633,276 to Shibata, et al., U.S. 3,616,109 to Miro, and U.S. 6,797,333 to Haase, et al.

2 (Original)

Rejected under 35 U.S.C. 103(a) on the basis of U.S. 5,472,755 to Nibling, Jr. in view of U.S. 4,633,276 to Shibata, et al., U.S. 3,616,109 to Miro, U.S. 6,797,333 to Haase, et al., and U.S. 5,530,517 to Patton, et al.

3-5 (Previously Presented) and  
6 (Original)

Rejected under 35 U.S.C. 103(a) on the basis of U.S. 5,472,755 to Nibling, Jr. in view of U.S. 4,633,276 to Shibata, et al., U.S. 3,616,109 to Miro, and U.S. 6,797,333 to Haase, et al.

7 (Previously Presented)

(1) Rejected under 35 U.S.C. 112, first paragraph.  
(2) Rejected under 35 U.S.C. 103(a) on the basis of U.S. 5,472,755 to Nibling, Jr. in view of U.S. 4,633,276 to Shibata, et al.,

U.S. 3,616,109 to Miro, and U.S.  
6,797,333 to Haase, et al.

8 (Original)

Rejected under 35 U.S.C. 103(a) on the  
basis of U.S. 5,472,755 to Nibling, Jr. in  
view of U.S. 4,633,276 to Shibata, et al.,  
U.S. 3,616,109 to Miro, U.S. 6,797,333 to  
Haase, et al., and U.S. 5,530,517 to  
Patton, et al.

9-11 (Original)

Rejected under 35 U.S.C. 103(a) on the  
basis of U.S. 5,472,755 to Nibling, Jr. in  
view of U.S. 4,633,276 to Shibata, et al.,  
U.S. 3,616,109 to Miro, and U.S.  
6,797,333 to Haase, et al.

### **STATUS OF AMENDMENTS**

No amendment has been made after the final rejection.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

In accordance with independent claim 1 (previously presented) the present invention for a runnable splice 10 (Figures 1-3) (page 4, line 20) includes a first thermal imprintable label stock 12 (Figures 1-3) (page 4, line 21) having a first face layer 14 (Figures 1-3) (page 4, line 14) of thermal sensitive paper 16 (Figure 2, page 4, line 22) removably adhered to a first silicone liner 20 (Figure 2) (page 4, line 20) by a first adhesive 22 (Figure 2) (page 4, line 22), the first thermal label stock 16 (Figure 2) (page 4, line 22) having a first end 26 (Figures 1-2) (page 4, line 24) disposed transverse to a length of the first thermal label stock 16 (Figure 2, page 4, line 22);

a second thermal imprintable label stock 30 (Figures 1-3) (page 4, line 27) is provided having a second face layer 32 (Figures 1-3) (page 4, line 28) of thermal sensitive paper 34 (Figure 2) (page 4, line 28) removably adhered to a second silicone liner 38 (Figure 2) (page 4, line 29) by a second adhesive 40 (Figure 2) (page 4, line 29), the second thermal label stock 30 (Figures 1-3) (page 4, line 27) having a second end 44 (Figures 1-2) (page 4, line 29) disposed transverse to a length of the second thermal label stock 30 (Figures 1-3) (page 4, line 27), the first 26 and second 44 ends being disposed in a parallel spaced apart relationship to form a splice gap 48 (Figure 2) (page 5, line 3) therebetween;

a third thermal imprintable label 52 (Figures 1-3) (page 5, line 6) is disposed over said splice gap 48 (Figure 2, page 5, line 3) and adhered to both the first 14 and second face 32 layers for enabling thermal printing over said splice gap 48 (Figure 2) (page 5, line 3); and

a splice tape 60 (Figure 2) (page 5, line 10) is disposed over said splice gap 48 (Figure 2) (page 5, line 3) and adhered to both the first and second silicone liners 20, 38 (Figure 3) (page 5, line 12) without a release coating, the adhesive of said splice tape 60 (Figure 2) (page 5, line 10) to the silicone liner 38 (Figure 2) (page 4, line 29) enabling removal of the liners 20, 38 from the face layers 14, 32 without separation of the liners 20, 38 from one another, the splice tape 60 (Figure 2) (page 5, line 10) having a width greater than said third imprintable label 52 (Figures 1-3) (page 5, line 3) in order to insure bonding between the third imprintable label 52 (Figures 1-3) (page 5, line 3) and the first and second layers 14, 32.

Dependent claim 2 (original) provides for a splice gap 48 (Figure 2) (page 7, line 6) with a width of between about 0 inches and about 0.125 inches and the third thermal label 52 (Figures 1-3) (page 7, line 6) has a width of between about 0.5 inches and about 3 inches.

Dependent claim 3 (original) provides for a splice gap 48 (Figure 2) (page 7, line 9) disposed at an angle of between about 0° degrees and about 40 degrees transverse to a longitudinal axis of the first and second thermal label stock 12, 30 (Figures 1-3) (page 7, line 10).

Dependent claim 4 (previously presented) provides for first face layer 14 (Figures 1-3)

(page 4, line 22) and second face layer 32 (Figures 1-3) (page 4, line 27) adhesion to the first silicone liner 20 (Figure 2) (page 4, line 23) and second silicone layer 38 (Figure 2) (page 4, line 29) respectively with a pressure sensitive adhesive.

Dependent claim 5 (previously presented) provides for thermal imprintable silicone liner 20, 38 (Figure 2) (page 7, line 25) and splice tape 60 (Figure 2) (page 7, line 26).

Dependent claim 6 (original) provides for the splice tape 60 (Figure 2) (page 5, line 10) having a width equal or greater than a third label 52 (Figures 1-3) (page 5, line 6) width.

Independent claim 7 (previously presented) provides for a first thermal imprintable label stock 12 (Figures 1-3) (page 4, line 21) having a first face layer 14 (Figures 1-3) (page 4, line 14) of thermal sensitive paper 16 (Figure 2, page 4, line 22), a first liner 20 (Figure 2) (page 4, line 23) and a pressure sensitive adhesive 22 (Figure 2) (page 4, line 22) disposed therebetween, the first thermal label stock 12 (Figures 1-3) (page 4, line 21) having a first end 22 (Figures 1-2) (page 4, line 24) disposed transverse to a length of the first thermal label stock 12 (Figures 1-3) (page 4, line 21);

a second thermal imprintable label stock 30 (Figures 1-3) (page 4, line 27) having a second face layer 32 (Figures 1-3) (page 4, line 28) of thermal sensitive paper 34 (Figure 2) (page 4, line 28), a second liner 38 (Figure 2) (page 4, line 22) and a pressure sensitive adhesive 40 (Figure 2) (page 4, line 29) disposed therebetween, the second thermal label stock 30 (Figures 1-3) (page 4, line 27) having a second end 44 (Figures 1-2) (page 4, line 29) disposed transverse to a length of the second thermal label stock 30 (Figures 1-3) (page 4, line 27), the first and second ends being disposed in a parallel spaced apart relationship to form a splice gap 48 (Figure 2) ((page 5, line 3) therebetween;

a third thermal imprintable label 52 (Figures 1-3) (page 5, line 6) disposed over said splice gap 48 (Figure 2) ((page 5, line 3) and adhered to both the first and second face layers 14, 32 for enabling thermal printing over said splice gap 48 (Figure 2) ((page 5, line 3); and

a splice tape 60 (Figure 2) (page 5, line 10) disposed over said splice gap 48 (Figure

2) ((page 5, line 3) and adhered to both the first and second liners 20, 38 without a release coating, the adherence of the splice tape 60 (Figure 2) (page 5, line 10) to the silicone liners 20, 38 enabling removal of the liners 20, 38 from the face layers 14, 32 without separating the liners 20, 38 from one another, said splice tape 60 (Figure 2) (page 5, line 10) having a width greater than said third imprintable label 52 (Figures 1-3) (page 5, line 6) in order to insure bonding between the third imprintable label 52 (Figures 1-3) (page 5, line 6) and the first and second layers 14, 32.

Dependent claim 8 (original) provides for a splice gap 48 (Figure 2) (page 7, line 6) with a width of between about 0 inches and about 0.125 inches and the third thermal label 52 (Figures 1-3) (page 7, line 6) has a width of between about 0.5 inches and about 3 inches.

Dependent claim 9 (original) provides for a splice gap 48 (Figure 2) (page 7, line 9) disposed at an angle of between about 10 degrees and about 40 degrees transverse to a longitudinal axis of the first and second thermal label stock 12, 30 (Figures 1-3) (page 7, line 10).

Dependent claim 10 (previously presented) provides for thermal imprintable silicone liners 20, 38 (Figure 2) (page 7, line 25) and split tape 60 (Figure 2) (page 7, line 26).

Dependent claim 11 (original) provides for the spit tape 60 (Figure 2) (page 5, line 10) having a width equal or greater than a thermal label 52 (Figures 1-3) (page 5, line 6) width.

### **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

#### **ENABLEMENT**

The Examiner has rejected claims 1 and 7 under 35 U.S.C. 112, first paragraph as failing to comply with the width description requirement.

OBVIOUSNESS

The Examiner has rejected claims 1-11 as being obvious over Nibling, Jr. in view of Shibata, et al. Miro, and Haase, et al., and Patton, et al.

GROUPING OF CONTESTED CLAIMS

No request is made for separate consideration of the claims.

ARGUMENT – ENABLEMENT – CLAIMS 1 AND 7

The Examiner has rejected claims 1 and 7 under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner has stated that the claims contain subject matter which was not described in the specification in a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The Examiner states that the amendments to the claims contain the language “without a release coating” and the area as referenced in the response (filed February 28, 2006), namely page 8, line 5 in the original specification, provides no support for the amendment.

The Appellant respectfully traverses the Examiner’s rejection as follows:

The claimed language identifies the splice tape disposed over the splice gap and adhered to both the first and second silicon layers without a release coating.

On page 5, beginning at line 10 of the original specification, it is set forth: “A splice tape 60 is disposed over the splice gap 48 and adhesive adheres the splice tape to both the first and second silicone layers 20, 38 and enables the removal of the liners 20, 38 from the face layers 14, 32 without



separation of the liners 20, 38.” Clearly, there is no mention of a release coating inasmuch as the adhesive adheres the splice tape directly to both the first and second silicone layers.

The reference to the specification on page 8 beginning at line 5 includes beginning at line 11: “Further, the invention illustratively disclosed herein suitably may be practiced in the absence of any element, which is not specifically disclosed herein.”

Accordingly, the Appellant has both directly and indirectly disclosed the application of a splice tape without a release coating. Therefore, the Appellant respectfully requests the Examiner to withdraw the rejection of claims 1 and 7 under 35 USC 112, first paragraph.

The Examiner has also rejected claims 1 and 7 under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. In this rejection, the Examiner states that there is no description in the Appellant’s specification as to how the silicone liners are constructed without involving coatings on a base layer.

The Appellant is unable to respond to this rejection due to the fact that the specification includes no reference to “a base layer”. Accordingly, the Appellant respectfully requests the Examiner to withdraw the rejection of claims 1 and 7 under 35 USC 112, first paragraph.

#### ARGUMENT – OBVIOUSNESS – CLAIMS 1, 3-7, 9-11

Claims 1, 3-7, and 9-11 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over U.S. 5,472,755 to Nibling, Jr. in view of U.S. 4,633,296 to Shibata, et al., U.S. 3,616,109 to Miro, and U.S. 6,797,333 to Haase, et al.

In this rejection, the Examiner states that Nibling discloses a runnable splice (column 1, lines 6-7) comprising a first imprintable label stock having a first phase layer of paper (column 6, lines 9-16), a first liner and a pressure sensitive adhesive disposed therebetween, the first label stock having

a first end disposed traverse to a length of the first label stock; a second imprintable label stock having a second phase layer of paper, a second liner and a pressure sensitive adhesive disposed therebetween, the second label stock having a second end disposed traverse to a length of the second label stock, the first and second ends being disposed in a parallel spaced apart relationship to form a splice gap therebetween.

The Examiner, however, acknowledges that Nibling, Jr. fails to disclose the imprintable label stock having a layer of thermal paper, the splice tape having a width greater than the third imprintable label in order to insure bonding between the third printable layer and the first and second layers and silicone liners without a release coating.

Therefore, the Examiner reaches to Shibata, et al. to teach a thermal sensitive recording label having a thermal sensitive color-forming layer disposed on one side of the substrate made of paper and an adhesive layer covered with a silicone release liner for the purpose of forming a label that is used on a variety of products without fading of the color formations over long periods of time.

The Examiner also refers to Miro as teaching a splice for pressure sensitive adhesive stock wherein the splice tape has a width greater than the labels in order to insure bonding between the third printable layer and the first and second layers for the purpose of forming a continuous roll.

Haase, et al. is cited by the Examiner as teaching silicone layers without a release coating, wherein the silicone liners are formed from the layer of liquid silicone that is cured with UV radiation for the purpose of allowing adhesive material to be separated from the liner material.

The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the thermal paper, a large splice and silicone layers in Nibling, Jr. in order to form a label that is used in a variety of products without the fading of the color formation over long periods of time from a continuous roll as taught by Miro and to allow the adhesive material to be separated from the liner material as taught by Haase, et al.

Importantly, in accordance with the present invention, the splice tape is disposed over the splice gap and adhered to both the first and second silicone liners without a release coating. This firm attachment by adhesive described in the original specification enables removal of the liners from the face layers without separation of the liners from one another.

This structure of applying the splice tape to the silicone layers without a release coating enables the function of removing the liners from the face layers without separation of the liners from one another and results from a complete and continuous separation.

No structure similar to the claimed structure is taught or suggested and the references relied on by the Examiner which functions in a manner similar to that of the structure of the present invention to result in complete removal of the liners intact from the face layers without separation of the liners from one another.

The Examiner alleges that the silicone liner of Nibling enables removal of the liners from the face layer without separating the liners from one another. However, this function is enabled by a release coating 74 which is applied to the butt joint to detachify, seal, or otherwise separate only the portion of the adhesive support tape to cover the butt joint to keep the first adhesive support 68 from bonding through the butt joint with the second adhesive support layer 76 which spans the width of the label stock 52 to adhesively join abutting ends 58 and 60 of the second phase 56 of the label stock 52.

This is in direct contrast to the present invention which utilizes a splice tape disposed over the splice gap without a release coating. Accordingly, Nibling, Jr. teaches away from the present invention. In addition, none of the secondary references, namely Shibata, Miro, or Haase, et al. teach or suggests this structure.

Thus, the Appellant respectfully submits that the Examiner has not made a prima facie case

of obviousness under 35 USC 103(a) of claims 1, 3-7, and 9-11 on the basis of the Nibling, Jr., Shibata, et al., Miro, and Haase, et al. references. Withdrawal of this rejection is respectfully requested.

ARGUMENT – OBVIOUSNESS CLAIMS 2 AND 8

Claims 2 and 8 have been rejected by the Examiner under 35 USC 103(a) as being unpatentable over Nibling, Jr. in view of Shibata, et al., Miro, and Haase, et al. and further in view of U.S. 5,530,517 to Patton, et al.

Since Nibling fails to disclose the third label as having a width between 0.5 inches and 3 inches the Examiner relies on Patton, et al. for teaching such dimensions and concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the label with the desired width in the splicing operation.

While Patton, et al., sets forth typical widths there is no further teaching of the structure of the splices hereinabove noted. Specifically, Patton is totally silent with regard to a splice tape disposed over a splice cap and adhered to both the first and second silicone layers without a release coating and further, wherein the splice tape has a width greater than the thermal imprintable label in order to insure bonding between the third imprintable label and the first and second layers.

As set forth in the original specification on page 6, at line 28, this difference in widths enables ends 70, 72 of the splice tape 60 not to be aligned with the ends 74, 76 of the label 52 and accordingly less stress is placed between the label 52 and the paper 16, 34 during removal operation.

Thus, the present invention provides for structure not taught or suggested by any of the references or combination thereof which functions in manner as the runnable splice in accordance with the present invention for insuring integrity of the splice by utilization of a splice tape width being greater than the third imprintable tape as hereinabove noted.

In conclusion, the Appellant submits that the Examiner has not made a prima facie case of obviousness under 35 USC 103(a) for claims 2 and 8 based upon the combination of Nibling, Jr., Shibata, et al., and Patton, et al. Withdrawal of this rejection is respectfully requested.

In view of the arguments hereinabove set forth, it is submitted that each of the claims now in the application define patentable subject matter not anticipated by the art of record and not obvious to one skilled in this field who is aware of the references of record. Reversal of the Examiner's rejection is respectfully requested.

Respectfully submitted,



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CLAIMS APPENDIX

1. (Previously Presented) A runnable splice comprising:
  - a first thermal imprintable label stock having a first face layer of thermal sensitive paper removably adhered to a first silicone liner by a first adhesive, the first thermal label stock having a first end disposed transverse to a length of the first thermal label stock;
  - a second thermal imprintable label stock having a second face layer of thermal sensitive paper removably adhered to a second silicone liner by a second adhesive, the second thermal label stock having a second end disposed transverse to a length of the second thermal label stock, the first and second ends being disposed in a parallel spaced apart relationship to form a splice gap therebetween;
  - a third thermal imprintable label disposed over said splice gap and adhered to both the first and second face layers for enabling thermal printing over said splice gap; and
  - a splice tape disposed over said splice gap and adhered to both the first and second silicone liners without a release coating, the adhesive of said splice tape to the silicone liner enabling removal of the liners from the face layers without separation of the liners from one another, said splice tape having a width greater than said third imprintable label in order to insure bonding between the third imprintable label and the first and second layers.
2. (Original) The runnable splice according to claim 1 wherein said splice gap has a width of between about 0 inches and about 0.125 inches and said third thermal label has a width of between about 0.5 inches and about 3 inches.
3. (Original) The runnable splice according to claim 2 wherein said splice gap is disposed at an angle of between about 0° degrees and about 40 degrees transverse to a longitudinal axis of the first and second thermal label stock.
4. (Previously Presented) The runnable splice according to claim 3 wherein the first face layer and second face layer are adhered to the first and second silicone liners respectively with a

pressure sensitive adhesive.

5. (Previously Presented) The runnable splice according to claim 4 where the silicone liner and splice tape are thermal imprintable.

6. (Original) The runnable splice according to claim 4 wherein said splice tape has a width equal or greater than the third external label width.

7. (Previously Presented) A runnable splice comprising:  
a first thermal imprintable label stock having a first face layer of thermal sensitive paper, a first liner and a pressure sensitive adhesive disposed therebetween, the first thermal label stock having a first end disposed transverse to a length of the first thermal label stock;  
a second thermal imprintable label stock having a second face layer of thermal sensitive paper, a second liner and a pressure sensitive adhesive disposed therebetween, the second thermal label stock having a second end disposed transverse to a length of the second thermal label stock, the first and second ends being disposed in a parallel spaced apart relationship to form a splice gap therebetween;  
a third thermal imprintable label disposed over said splice gap and adhered to both the first and second face layers for enabling thermal printing over said splice gap; and  
a splice tape disposed over said splice gap and adhered to both the first and second liners without a release coating, the adherence of said splice tape to the silicone liner enabling removal of the liners from the face layer without separating the liners from one another, said splice tape having a width greater than said third imprintable label in order to insure bonding between the third imprintable label and the first and second layers.

8. (Original) The runnable splice according to claim 7 wherein said splice gap has a width of between about 0 inches and about 0.125 inches and said third thermal label has a width of between about 0.5 inches and about 3 inches.

9. (Original) The runnable splice according to claim 8 wherein said splice gap is disposed at an angle of between about 10 degrees and about 40 degrees transverse to a longitudinal axis of the first and second thermal label stock.

10. (Previously Presented) The runnable splice according to claim 9 where the silicone liner and splice tape are thermal imprintable.

11. (Original) The runnable splice according to claim 9 wherein said splice tape has a width equal or greater than the third external label width.



**EVIDENCE APPENDIX**

NONE

RELATED PROCEEDINGS APPENDIX

NONE